

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD T. RIGG, JOHN R. CASTRO,
PAMELA A. PETRO and JOHN A. SZWEDA

Appeal No. 1996-2312
Application 08/110,274¹

MAILED

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**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

ORDER DENYING REQUEST FOR ORAL HEARING
AND ORDER REMANDING TO EXAMINER

Effective April 21, 1995, 37 CFR § 1.192(c)² was amended to provide as follows (underlining added for emphasis):

(c) The brief shall contain the following items under appropriate headings and in the order indicated below unless the brief is filed by an applicant who is not represented by a registered practitioner:

(1) Real party in interest. A statement identifying the real party in interest, if the party named in the caption of the brief is not the real party in interest.

¹ Application for patent filed August 23, 1993.

² 60 F.R. 14518 (March 17, 1995), 1173 O.G. 62 (April 11, 1995).

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(2) Related appeals and interferences. A statement identifying by number and filing date all other appeals or interferences known to appellant, the appellant's legal representative, or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

The brief filed May 15, 1995 (Paper No. 12) is defective under 37 CFR § 1.192(d) because it fails to comply with the provisions of the rule pertaining to both the "real party in interest" and "related appeals and interferences."

The Manual of Patent Examining Procedure (MPEP) § 1206 (7th Ed., July 1998) states:

If appellant does not name a real party in interest, the examiner will assume that the party named in the caption of the brief is the real party in interest, i.e., the owner at the time the brief is being filed.

... While the examiner will assume that the real party in interest is the individual or individuals identified in the caption when the real party in interest is not explicitly set out in the brief, nevertheless, the Board may require the appellant to explicitly name the real party in interest.

MPEP § 1206 further states:

... If appellant does not identify any other appeals or interferences, the examiner will presume that there are none. While the examiner will assume that there are no related cases when no related case is explicitly set out in the brief, nevertheless, the Board may require the appellant to explicitly identify any related case.

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The examiner may presume that the real party in interest is the party named in the caption of the brief and that there are no related appeals and interferences, if applicants present the headings but fail to provide the corresponding statements under the headings. Nevertheless, the examiner is encouraged to request from applicants not only the required headings but also explicit statements naming the real party in interest and identifying any related appeals and interferences in order to avoid further delays in the appeal process, since the Board will otherwise require applicants to explicitly identify the real party in interest and any related appeals and interferences.

An Information Disclosure Statement (IDS) (Paper No. 8) was filed March 20, 1995. There is no indication in the record that the IDS was considered according to the criteria set forth in 37 CFR §§ 1.97 and 1.98. A communication notifying applicants of the primary examiner's decision is required. See MPEP § 609(c) (7th Ed., July 1998).

On September 8, 1995, an Examiner's Answer (Paper No. 13) was mailed. The Request for Oral Hearing (Paper No. 15) was filed December 4, 1995 with a certificate of mailing under 37 CFR § 1.8 dated December 1, 1995. Pursuant to 37 CFR § 1.194(b), the Request for Oral Hearing was due two months from the date of the Examiner's Answer. The due date for this request was November 8, 1995.

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Therefore, the Request for Oral Hearing was not timely filed.

37 CFR § 1.136 states:

(a)(1) If an applicant is required to respond within a nonstatutory or shortened statutory time period, applicant may respond up to four months after the time period set if a petition for an extension of time and the fee set in § 1.17 are filed prior to or with the response, unless:

....

(iii) The response is a request for oral hearing submitted pursuant to § 1.194(b),

....

(b) When a response with petition and fee for extension of time cannot be filed pursuant to paragraph (a) of this section, the time for response will be extended only for sufficient cause, and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the applicant is due.

Since the provisions of 37 CFR § 1.136(a)(1)(iii) were not available for a request for oral hearing and applicants have failed to petition under the provisions of 37 CFR § 1.136(b), the request for oral hearing is not timely filed.

Accordingly, it is

ORDERED that the Request for Oral Hearing (Paper No. 15) is denied as being not timely filed. The appeal will be assigned for consideration and decision on the written record; and it is

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FURTHER ORDERED that the application is remanded to the examiner
for resolution of the issues set forth above:

- regarding both the "real party in interest" and "related appeals and interferences;"
- consideration of the IDS (Paper No. 8, dated March 20, 1995), appropriate notification to applicants of the action taken; and
- for such further action as may be deemed appropriate.

BOARD OF PATENT APPEALS
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